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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/618,741	07/18/2000	Thomas M. Hartnett	07206-118001	8640	
22494	7590 01/10/2005		EXAM	EXAMINER	
DALY, CROWLEY & MOFFORD, LLP			HOFFMAN	HOFFMANN, JOHN M	
SUITE 101 275 TURNPI	SUITE 101 275 TURNPIKE STREET			PAPER NUMBER	
CANTON, N	CANTON, MA 02021-2310				

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
	09/618,741	HARTNETT ET AL.	
Office Action Summary	Examin r	Art Unit	
	John Hoffmann	1731	
The MAILING DATE of this communication Period f r Reply	appears on the cov r sh et w	th th correspondenc addre	9ss
A SHORTENED STATUTORY PERIOD FOR RETHE MAILING DATE OF THIS COMMUNICATION - Extensions of time may be available under the provisions of 37 CF after SIX (6) MONTHS from the mailing date of this communication of the period for reply specified above is less than thirty (30) days, or if NO period for reply is specified above, the maximum statutory period for reply within the set or extended period for reply will, by some and patent term adjustment. See 37 CFR 1.704(b).	ON. R 1.136(a). In no event, however, may a r n. a reply within the statutory minimum of thin eriod will apply and will expire SIX (6) MON tatute, cause the application to become AE	eply be timely filed by (30) days will be considered timely. ITHS from the mailing date of this comm BANDONED (35 U.S.C. § 133).	nunication.
Status			
1) Responsive to communication(s) filed on 1	14 October 2004.		
	This action is non-final.		
3) Since this application is in condition for all		ers, prosecution as to the m	erits is
closed in accordance with the practice und		-	
Disposition of Claims			
4) ☐ Claim(s) 8,10-13 and 32-52 is/are pending 4a) Of the above claim(s) is/are with 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) 8,10-13 and 32-52 is/are rejected 7) ☐ Claim(s) is/are objected to. 8) ☐ Claim(s) are subject to restriction as	drawn from consideration.		
Application Papers			
9) The specification is objected to by the Exar 10) The drawing(s) filed on is/are: a) Applicant may not request that any objection to Replacement drawing sheet(s) including the co 11) The oath or declaration is objected to by the	accepted or b) □ objected to the drawing(s) be held in abeyar rection is required if the drawing	nce. See 37 CFR 1.85(a). (s) is objected to. See 37 CFR	, ,
Priority under 35 U.S.C. § 119			•
12) Acknowledgment is made of a claim for force a) All b) Some * c) None of: 1. Certified copies of the priority docum 2. Certified copies of the priority docum 3. Copies of the certified copies of the application from the International Bu * See the attached detailed Office action for a	nents have been received. nents have been received in A priority documents have been reau (PCT Rule 17.2(a)).	pplication No received in this National Sta	age
Attachment(s)	4) [] t	Nummery (PTO 442)	
 Notice of References Cited (PTO-892) Dotice of Draftsperson's Patent Drawing Review (PTO-948) 		Summary (PTO-413) s)/Mail Date	
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SE Paper No(s)/Mail Date		nformal Patent Application (PTO-15	52)

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 14 October 2004 has been entered.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

⁽a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 10-11, 13 and 32-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire 4686070 alone, or in view of Serpek 1030929.

See how the reference were applied before.

As indicated in the previous prior art rejections, Maquire discloses the mixing of the ingredients at the claimed temperature, and including nitrogen so as to create aluminum oxynitride. However, Maquire does not disclose all of the specifics: the chamber; the steps being done continuously/simultaneously; and the predetermined temperature. None of these features are patentable modifications – absent a showing of new and unexpected results or some other overriding secondary consideration. It would have been obvious to perform the Maquire process in a continuous process for all of the inherent benefits thereof.

From MPEP 2144.04:

E. Making Continuous

In re Dilnot, 319 F.2d 188, 138 USPQ 248 (CCPA 1963) (Claim directed to a method of producing a cementitious structure wherein a stable air foam is introduced into a slurry of cementitious material differed from the prior art only in requiring the addition of the foam to be continuous. The court held the claimed continuous operation would have

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been obvious in light of the batch process of the prior art.).

As to the nitrogen being added while mixing: From MPEP 2144.04

C. Changes in Sequence of Adding Ingredients
Ex parte Rubin , 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

In other words, there is no invention as to the order in which the materials/gases are added. As to the predetermined temperature: a continious process inherently requires a specific constant temperature along the process – otherwise it is not continuous – it is varying. Furthermore, one would be motivated to keep the temperature (and all other parameters) essentially constant – otherwise there is a likelihood that varing parameters would result in varying product characteristics. Since Maquire teaches 1750 C - one would keep it at 1750 C and not change it.

Serpek can also be applied as done previous

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire and optionally in view of Serpek as applied to claim 11 above, and further in view of Abstract of JP403023269A or Dodds 5925584.

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See how these references were applied in the previous rejections – for example that of April 6, 2003.

Response to Arguments

Applicant's arguments filed 7 April 2003 have been fully considered but they are not persuasive. The arguments discuss the use of a single temperature, continiously mixing, and other continuous aspects of the claims. As indicated in the above rejection, these are usually obvious modifications. Applicant has not demonstrated that the invention is anything more than the simple conversion of a batch process to a continuous process. See the 40-year-old case law cited above which shows such is obvious.

As to the use of a single temperature: various Maguire claims clearly refer to "a temperature". A fair reading of this is that it means a single temperature – not multiple temperatures as applicant incorrectly suggests.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

Business Center (EBC) at 866-217-9197 (toll-free).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic

John Hoffmann \ Primary Examiner

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jmh